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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,958	06/27/2003	Michael Jurs	WK-186-02	4843

7590 12/31/2003
MATTINGLY, STANGER & MALUR
Suite 370
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Alexandria, VA 22314

EXAMINER

NELSON, JUDITH A

ART UNIT	PAPER NUMBER
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3644

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/606,958	JURS ET AL.	
	Examiner	Art Unit	
	Judith A. Nelson	3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>06/27/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

This application discloses and claims only subject matter disclosed in prior Application No. 09/744,519, filed 04/19/2001, of U.S. Patent 6,604,991 and names an inventor or inventors named in the prior application. The first sentence of the specification should be updated to reflect the patent number given to the above mentioned parent case.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The

disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because of the recitation of "means", in lines 1, 2, and 3 of the abstract. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 11-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, the phrase, "and/or", is repeatedly used (note lines 5, 7 and 10). The recited language is alternative in nature and does not clearly define the scope of Applicants' invention. Appropriate correction to the claim is required.

Also regarding claim 11, the recitation in lines 8-9 of "information to be recorded and processed into data of at least two kinds, *namely*, geometric data of the flesh and image data of the flesh". The recitation renders the claim indefinite, because it is unclear as to whether the limitations following the phrase "*namely*", are part of the invention. Appropriate correction to the claim is required.

In claim 21, the phrase, "and/or", is also repeatedly used (note lines 6 and 12). The recited language is alternative in nature and does not clearly define the metes and bounds of the patent protection desired. Appropriate correction to the claim is required.

Also regarding claim 21, the recitation in lines 8-9 of "information to be recorded and processed into data of at least two kinds, namely, geometric data of the flesh and image data of the flesh". The recitation renders the claim indefinite, because it is unclear as to whether the limitations following the phrase are part of the invention. Appropriate correction to the claim is required.

Regarding claim 22, the word "means" is preceded by the word(s) "recorded by" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). The Examiner suggest, stating the claim limitation as follows: --wherein images are recorded by a camera.--.

In claim 23, the phrase, "and/or", is recited in line 3 of the claim. The recited language is alternative in nature and does not clearly define the metes and bounds of the patent protection desired. Appropriate correction to the claim is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11-24 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent 5,591,076, issued to Evers et al (reference "AE" as listed on Applicant's Form PTO 1449).

Evers et al disclose the claimed invention including, inter alia, method of use for and an apparatus comprising:

a transport means (1 and 1.1);

an element (3.4) which detects the position of the flesh;

a separating means (4.1) for making variant cuts of the flesh; and

a regulating control device (6), electronically associated (see fig. 6; and col. 5, lines 49-68; col. 6, lines 1-68; and col. 7, lines 1-12) with the element for detecting the position of the flesh; the separating means (4.1) and the transport means (1 and 1.1).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,604,991. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent completely encompass the claimed subject matter of the application, for instance a device for processing flesh including at least one transport means; at least one element which detects the position of the flesh; at least one separating means for making variant cuts of the flesh; at least one regulating or control device, wherein the element is electronically connected with the separating means via the regulating or control device, and said element provides information to be recorded and processed into data of at least two kinds (geometric data of the flesh and image data of the flesh) so that separating cuts or trimming cuts can be made with the separating means.

Also claims 11-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-20 of U.S. Patent No. 5,591,076. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent encompass the claimed subject matter of the application, for instance a device for processing fish flesh including at least one transport means (in combination structures 1 and 1.1); at least one element which detects the position of the flesh (3.4); at least one separating means for making variant cuts of the flesh (4.1); at least one regulating or control device (6), wherein the element is electronically connected with the separating means via the regulating or control device (6), and said element provides information to be recorded and processed into data of at least two kinds (geometric data of the flesh and image data of the flesh) so that separating cuts or trimming cuts can be made with the separating means (4.1) and it furthermore appears that the application and patent maybe commonly owned (by Nordischer Maschinenbau Rud. Baader GmbH & CO KG).

Conclusion

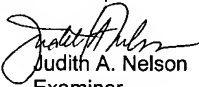
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Foreign Patent DE 3239125.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judith A. Nelson whose telephone number is (703) 305-0984. The examiner can normally be reached on M-Thur. 9:00 a.m. - 6:30 p.m., alt. Fri..

Art Unit: 3644

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles T. Jordan can be reached on 306-4159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 306-4180.


Judith A. Nelson
Examiner
Art Unit 3644

jan
12/22/03